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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,248	03/04/2002	Michel Philippe	05725.1032-00	7789
7590	11/07/2003		EXAMINER	
Thomas L. Irving FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P. 1300 I Street, N.W. Washington, DC 20005-3315			CRIARES, THEODORE J	
			ART UNIT	PAPER NUMBER
			1617	8
DATE MAILED: 11/07/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.



## **CLAIMS 1-27 ARE PRESENTED FOR EXAMINATION**

### **DETAILED ACTION**

Applicant's election with traverse of Group I, claims 1 and 14-17 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that there is no undue burden on the examiner to examine both the composition and method claims. This is not found persuasive because there is an undue burden placed on the examiner since there are different criteria in the examination of composition claims from those required of method claims. Further, an undue burden is placed on the examiner, specifically since it is required that there be complete search of the cosmetic and chemical compound literature. In addition, classes 424 and 514 are required to be searched for relevant art first for the compound and secondly for the compound within the composition as a moisturizer

The requirement is still deemed proper and is therefore made FINAL.

Claims 2-13 and 18-27 are withdrawn from consideration.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1 and 14-17 are rejected under 35 U.S.C. 102(a) as being anticipated by Phillippe et al. (WO 99/49837, hereinafter referred to as '937).

'937 teaches in the abstract applicants' claimed compounds used for strengthening and care of keratinous fibre . The application of applicants' claimed known compounds, as taught by '937, would inherently prevent drying out keratin fibres as claimed by applicants. In other words once thecompounds are used for a different purpose they would be preventing any other claimed condition. See *Ex parte Novitski* 26 USPQ2d 1389.

### **DOUBLE PATENTING**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 14-17 are rejected under the judicially created doctrine of double patenting over claims 23, 24, 25, 27, and 28 of U. S. Patent No. 6,585,962 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is obvious from the teachings in the patent and claims therein. The claims of the patent are drawn to applying applicants' compounds to lips (claim 23), in the form of lipstick (claim 24), skin (claim 25), protective body milk (claim 27), and a night product (claim 28). The difference between these claims and applicants' claims is that applicants are claiming a moisturizing feature. However, the skilled artisan would have been motivated to use applicants' known claimed compounds to moisten the skin since the compounds were previously disclosed in the manner setforth above which are used to keep the skin and lips moist.

This obvious type double Patenting rejection is deemed proper.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

None of the claims are allowed..

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theodore J. Criares whose telephone number is 308-4607. The examiner can normally be reached on 6:30 A.M. to 5:00P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 305-1877. The fax phone

Art Unit: 1617

number for the organization where this application or proceeding is assigned is (703)  
872-9306.

Any inquiry of a general nature or relating to the status of this application or  
proceeding should be directed to the receptionist whose telephone number is 308-1235.



Theodore J. Criares  
Primary Examiner  
Art Unit 1617

tjc  
11/05/03